

**REMARKS**

Applicants have amended claim 41 to overcome the rejection under 35 U.S.C. 112 and to include all of the limitations of base claim 40. Claims 42 and 43 depend from claim 41 and thus now include such limitations as well. Claims 44, 46, and 47 have been amended to depend from claim 41. Claims 45 and 50 have been amended so that they are written in independent form and include all of the limitations of respective base claims 40 and 48. Claims 40, 41, 43, 45-48, and 50-53 have been amended to clarify aspects of the present invention. Claims 40-55 are now pending. No new matter has been added.

In the Office Action dated April 29, 2004, the Examiner found allowable subject matter in claims 45 and 50 and indicated that these claims would be allowable if they were rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In addition, although claims 41 and 42 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, the Examiner indicated that claims 41 and 42 would be allowable if they were rewritten to overcome the rejections under 35 U.S.C. 112 and to include all of the limitations of the base claim and any intervening claims. In particular, the Examiner rejected claim 41 because the claim did not disclose how the calculation of a "projected amount of sales" is utilized other than as a transmission to a host computer, and claim 42 as being dependent on rejected claim 41.

The Examiner also rejected claims 40, 43, 44, 46, 48, 49, and 51-55 under 35 U.S.C. 103(a) as being unpatentable over Boesch et al (U.S. Patent No. 6,205,433) in view of Potter et al (U.S. Patent No. 5,787,402), and claim 47 under 35 U.S.C. 103(a) as being unpatentable over Boesch in view of Potter and further in view of Garber (U.S. Patent No. 5,963,923).

The Applicants appreciate the Examiner's continued efforts in this case and his indication of allowable subject matter in claims 41, 42, 45 and 50. Applicants also respectfully traverse all rejections under 35 U.S.C. 103(a) for the reasons set forth herein. Applicants have addressed each of the Examiner's concerns for the currently pending claims and indicated why the currently pending claims are not obvious in view of Boesch, Potter, Garber, or any combination thereof, and respectfully request that the Examiner allow all pending claims.

**A. Allowable Subject Matter**

Applicants have reviewed the April 29, 2004 Office Action and amended claims 45 and 50 to rewrite them in independent form including all of the limitations of the base claim and any intervening claims. In addition, the Applicants have amended claim 41 to indicate that the currency exchange price that relates a base currency to a foreign currency is based upon the projected amount of sales. Applicants respectfully submit that such claimed use of the projected amount of sales further clarifies the utilization of the calculated projected amount of sales. Applicants have also amended claim 41 to include the limitations of base claim 40. As such, claim 42, which depends from claim 41, includes the limitations of base claim 40 and 41. Applicants therefore respectfully request the allowance of claims 45, 50, 41, and 42.

Applicants have also amended claims 44, 46, and 47 so that they depend from claim 41. Claim 43 in its current form depends from claim 41 as well. Applicants therefore submit that claims 43, 44, 46, and 47 are also in condition for allowance because they include the limitations of allowable independent claim 41, as well as the additional limitations included in each respective dependent claim.

**B. 35 U.S.C. §103**

The Examiner has repeatedly cited three U.S. patents to reject claims 40, 43, 44, 46-49, and 51-55 under 35 U.S.C. 103(a). These patents are Boesch et al. (U.S. Patent No. 6,205,433), Potter et al. (U.S. Patent No. 5,787,402), and Garber (U.S. Patent No. 5,963,923). Applicants respectfully traverse these rejections.

As Applicants have previously discussed in their responses to prior Office Actions, in order to establish a case of obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the Applicants' disclosure. MPEP 706.02(j), citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicants again respectfully submit that the Examiner has not met his burden for establishing a case of obviousness because (a) there is no motivation to modify or combine the

reference teachings and (b) even if the references were combined, none of the prior art references, alone or in combination, describe or suggest all of the claimed limitations.

There Is No Motivation To Combine The Prior Art

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the arts.” In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). None of these three possible sources have been demonstrated in the Office Action dated April 29, 2004.

The Examiner has opined that it would have would have been obvious for one schooled in the art to modify Boesch according to Potter or to combine the two references because Potter teaches inputs required for a transaction to commence. Applicants respectfully point out that numerous data processing systems that take action on data involved in a transaction require the input of data required for the transaction to commence. In particular, many financial transaction data processing systems require transaction commencement data to be input. The Examiner’s logic thus leads to the unreasonable conclusion that it would be obvious to modify Boesch in view of, or combine Boesch with the vast number of financial transaction data processing systems that require transaction commencement data as input. Applicants therefore respectfully submit that the Examiner has not met his burden of showing a motivation to modify Boesch in view of Potter or to combine the two references.

Similarly, the Examiner has unconvincingly contended that it would be obvious to modify Boesch in view of Garber because Garber teaches risk in currency transactions. All currency transactions involve risk. As such, the Examiner’s contention calls for the unreasonable conclusion that it would be obvious to combine Boesch with all prior currency transactions. Thus, the Examiner has failed to show a motivation to modify Boesch in view of Garber as well.

A person of ordinary skill in the art is presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient and often expensive, systematic research or by extraordinary insights. Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 454, 227 U.S.P.Q. (BNA) 293, 298 (Fed. Cir. 1985). A person of ordinary skill in the art has even been characterized as a “routineer.” Application of Laverne, 53 C.C.P.A. 1158, 356 F.2d 1003, 1006, 148 U.S.P.Q. (BNA) 674, 676 (1966).

The conventional and routine methods incorporated by the industry have proven to be problematic since they do not allow a purchaser to readily ascertain a sale price the purchaser will ultimately pay for a product and/or service in the local currency, nor do such methods provide the seller with a vehicle with which the seller can determine a sale price for a good and/or service in a foreign currency which is effective for a predetermined period of time. Accordingly, the present invention solves these problems, and as explained above, it is unreasonable to contend that it would have been obvious to a person of ordinary skill to combine Boesch with a virtually limitless set of prior transaction systems in order to provide a solution to this problem.

The Prior Art Does Not Describe Or Suggest The Claimed Limitations

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). The prior art has been discussed in previous correspondence with the Examiner, and the Applicants direct the Examiner to the responses filed in reply to the Office actions of November 19, 2003 and July 14, 2003.

As claimed in currently amended independent system claim 40, the present invention accomplishes transparent foreign exchange using several unique aspects which are not described or suggested in Boesch, or any of the other cited art. Four of these unique aspects are discussed below.

First, the present invention includes a currency exchange price which is effective for amounts of currency involved in multiple transactions comprising goods and services sold by the seller. By associating the exchange rate with a particular seller, the present invention allows a currency exchange provider to take into consideration the type of goods and services sold by the seller, and market data associated with such goods and services. Accordingly, sales volume and transaction size can be taken into consideration when determining the currency exchange rate. None of the prior art differentiates between particular sellers.

Adhering to a currency exchange price for transactions comprising specific goods or services sold by a specific seller brings predictability to the seller's marketplace and allows the seller to proactively present a price for goods and services to a potential customer that is denominated in a currency local to the customer. None of the prior art provides a seller with such a tool.

Second, the present invention includes a predetermined period of time during which the currency exchange price is effective. This aspect brings predictability to both the currency exchange entity and the seller's marketplace by allowing a buyer and seller to rely that during a predetermined time period the price of the goods or services will not change due to fluctuating currency exchange rates. This aspect also allows a currency exchange provider to understand the amount of risk exposure associated with a particular exchange rate guaranteed to a particular seller for that particular seller's goods and services.

Third, according to the present invention, a seller may only present amounts that result from executed transactions, transacted by that particular seller, and must include the amount of foreign currency involved in the transactions as well as the date of execution. Fourth, the present invention requires that a determination be made that the transactions were executed during the period of time during which the currency exchange price is effective. These third and fourth aspects, as well as the claimed invention as a whole, therefore provide continuity and predictability to the seller's marketplace and limit the risk exposure faced by a currency exchange provider, thus creating a practical and workable solution to a problem not previously solved. No combination of the cited prior art provides for such a solution.

Generally, independent claim 48 includes similar limitations as claim 40, but presents the limitations in the form of method steps performed by a seller implementing some embodiments of the present invention. In addition, claim 48 includes at least two additional unique claim limitations that are not described or suggested by the cited prior art. A first limitation includes calculating a price for goods and/or services offered for sale by a seller. The price is denominated in a foreign currency and is calculated using the price of the goods and/or services denominated in the base currency and the currency exchange rate tied to the seller's goods and/or services for the predetermined period of time. Another additional unique limitation includes generating an actual offer for sale for the seller's goods and/or services. The offer for sale includes the calculated selling price denominated in a foreign currency and is limited to a time period based upon the predetermined time period during which the currency exchange price is effective.

As discussed herein and in the previous correspondence with the Examiner, the Applicants respectfully submit that Boesch, alone or in view of Potter and/or Garber, does not describe or suggest the claimed invention and therefore does not provide proper grounds for

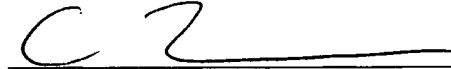
rejection. What would be necessary to support a rejection of currently pending claims 40, 48, 49, and 51-55 under 35 U.S.C. 103(a) is one or more references that describe or suggest a computer system and computer implemented method that incorporate the unique aspects described above and in the previous correspondence. Boesch clearly does not provide such a description or suggestion, either alone or in combination with Potter and/or Garber.

**CONCLUSION**

For the reasons set forth above, allowance of this application, as amended, is courteously urged.

Respectfully submitted,

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